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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,017	04/20/2004	David B. Sanderson	707083.4012	5969

34313 7590 06/01/2007  
ORRICK, HERRINGTON & SUTCLIFFE, LLP  
IP PROSECUTION DEPARTMENT  
4 PARK PLAZA  
SUITE 1600  
IRVINE, CA 92614-2558

EXAMINER
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CASTELLANO, STEPHEN J

ART UNIT	PAPER NUMBER
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3781

MAIL DATE	DELIVERY MODE
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06/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/829,017

**Applicant(s)**

SANDERSON, DAVID B.

**Examiner**

Stephen J. Castellano

**Art Unit**

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-20-04</u> . | 6) <input type="checkbox"/> Other: ____  |

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Claims 1-12 have been canceled. Claims 13-21 are pending.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims (drawings) of U.S. Patent No. D479398 to Sanderson in view of Gilbertson, Luebke, Homoly, Kivett and Street. Sanderson discloses the tube case invention except for the internal working members of the latch. Gilbertson teaches the internal working members of the latch. It would have been obvious to add the latch member to secure the attachment of the two sections of the tube case.

Claims 13-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6729489 to Sanderson. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of Sanderson disclose all the elements of claims 13-19 and more. It would

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have been obvious to remove the unnecessary elements of Sanderson if such are not needed.

This is an In re Goodman situation.

Claims 20 and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6729489 to Sanderson in view of Street. Sanderson is applied as above and claims all the presently claimed structure except for the wheels. Street teaches wheels connected to one end of a two part container. It would have been obvious to add wheels to easily transport a bulky, heavy tube case container by rolling.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13, 14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilbertson.

Gilbertson discloses a two section tube case with the latching mechanism comprising of latch bracket (open end portion of section 11 with shoulder (open end edge) and slot 26, a stop (portion of open end edge of section 12 that engages shoulder (see Fig. 3 and 4)), latch 18 with slot engaging member 20.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbertson in view of Luebke.

Gilbertson discloses the invention except for the triangular cross section. Luebke teaches a triangular cross section. It would have been obvious as a matter of design choice to modify the shape to be triangular in cross section to better fit with an item or items having a similar triangular shape.

Claims 13, 14, 16, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Homoly or Nathan in view of Gilbertson.

Homoly discloses a tube case for a set of golf clubs. Since the clubs could be placed within a flexible plastic bag large enough to hold at least two clubs such as a trash liner bag and the bag can be collapse to be placed within Homoly, Homoly is dimensioned to hold a golf bag. Homoly is large enough to hold an elongated article and is large enough to hold a fishing rod. Homoly discloses handle 33.

Nathan discloses a tube case for an elongated article and is large enough to hold a fishing rod. Nathan discloses handle 56.

Homoly and Nathan disclose the invention except for the latching mechanism. Gilbertson teaches the latching mechanism as previously stated. It would have been obvious to modify the tube cases of either Homoly or Nathan to have the latch mechanism of Gilbertson to securely hold the two sections of the tube case together.

Claims 13, 14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kivett in view of Gilbertson.

Kivett discloses a tube case. Kivett disclose the invention except for the latching mechanism. Gilbertson teaches the latching mechanism as previously stated. It would have been obvious to modify the tube cases of Kivett to have the latch mechanism of Gilbertson to securely hold the two sections of the tube case together.

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbertson in view of Street et al. (Street).


Gilbertson discloses the invention except for the handle and wheels. Street teaches a handle and wheels. It would have been obvious as a matter of design choice to modify Gilbertson to have a handle and wheels to provide component which assist in rolling transport to make moving and carrying easier.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Castellano whose telephone number is 571-272-4535. The examiner can normally be reached on increased flexibility plan (IFP).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony D. Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Stephen J. Castellano  
Primary Examiner  
Art Unit 3781

sjc